Immunocept, LLC, et al v. Fulbright & Jaworski Doc. 20

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

FILED

DEC 27 2005

CLERK, U.S. DISTRICT COURT
WESTERN DISTRICT OF TEXAS
BY ______
DEPUTY CLERK

IMMUNOCEPT, LLC, PATRICE ANNE LEE, AND JAMES REESE MATSON, §
§
§
Plaintiffs, §
§
v. § CAUSE NO. A050A334 SS
§
FULBRIGHT & JAWORSKI, LLP, §
§
Defendant. §

DEFENDANT FULBRIGHT & JAWORSKI, LLP'S RESPONSE TO PLAINTIFFS' MOTION TO COMPEL TESTIMONY OF SARAH BRASHEARS

COMES NOW, Fulbright & Jaworski, LLP ("Fulbright"), and files this Response to Plaintiffs' Motion to Compel Testimony of Sarah Brashears and in support thereof, would respectfully show the Court as follows:

I. SUMMARY

The Plaintiffs seek to compel from former Fulbright attorney Sarah Brashears two categories of testimony, including information related to: (1) communications with Tom Paul, a partner at Fulbright; and (2) communications with outside counsel for Fulbright in the instant litigation. The Plaintiffs allege that various Fulbright attorneys committed negligent acts in prosecuting the '418 patent. Ms. Brashears was an attorney with Fulbright through 1996, and performed some of the work on the '418 patent application about which the Plaintiffs complain. Ms. Brashears is no longer associated with Fulbright, and is not under the control of Fulbright.

The Plaintiffs' motion to compel the deposition testimony of Sarah Brashears is riddled with errors, both procedural and substantive. The most glaring problems are that: (1) Plaintiffs

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have not filed their motion in the right court; (2) Plaintiffs have not given the notice required by Federal Rule of Civil Procedure 37; and (3) Plaintiffs have ignored numerous decisions in both appellate and district federal courts holding that communications by an employer or the employer's counsel with a former employee are protected by the work-product and attorney-client privileges. Each of these failures provides independent grounds for denying the Plaintiffs' motion to compel, and will be addressed in turn.

II. A MOTION TO COMPEL TESTIMONY IN CALIFORNIA MUST BE FILED IN CALIFORNIA

As a threshold matter, the Plaintiffs have filed their motion in the wrong judicial district. Ms. Brashears lives and works in California. ***See* Affidavit of Sarah Brashears, ¶ 3, Appendix, Exhibit A.** The subpoena issued by Plaintiffs' counsel for Ms. Brashears's testimony was issued from the Northern District of California, as called for by Federal Rule of Civil Procedure 45(a)(2)(B). ***See* Appendix, Exhibit B.**

"An application for an order [compelling disclosure or discovery] to a person who is not a party shall be made to the court in the district where the discovery is being, or is to be, taken." FED. R. CIV. P. 37(a)(1). In other words, if a party moves to compel discovery from a nonparty such as Ms. Brashears, it must file its motion in the district where the discovery is to be taken. *In re Sealed Case*, 141 F.3d 337, 341 (D.C. Cir. 1998). This is because "the [federal] rules governing subpoenas and nonparty discovery have a clearly territorial focus." *See id.* In this case the "district where the discovery is to be taken" is the Northern District of California, ***not*** the Western District of Texas. To compel Ms. Brashears's testimony, the Plaintiffs must file a motion in the Northern District of California. They have not done so.

In short, the Plaintiffs are asking this Court to order that "Sarah Brashears shall make herself available for deposition." *See* [Proposed] Order Granting Plaintiffs' Motion to Compel Testimony of Sarah Brashears. Respectfully, this Court does not have jurisdiction over Ms. Brashears, who is a California resident, that would permit issuance of such an order.

III. PLAINTIFFS DID NOT GIVE THE "REASONABLE NOTICE" REQUIRED BY RULE 37

Even if the Plaintiffs had filed their motion in a proper federal district, they failed to comply with other mandates of Federal Rule of Civil Procedure 37. Specifically, they did not give "reasonable notice to . . . all persons affected" by the contemplated order compelling discovery. FED. R. CIV. P. 37(a). The prospective deponent herself -- Ms. Brashears -- was given no notice whatsoever by the Plaintiffs. ***See* Affidavit of Sarah Brashears, ¶ 13, Appendix, Exhibit A**; *see Fischer v. McGowan*, 585 F. Supp. 978, 983 (D. R.I. 1984) ("Although the deponent was not a party to the litigation, it is beyond cavil that he was . . . a person 'affected' by the motions to compel.").

The Tenth Circuit, holding that the "reasonable notice" of Rule 37 and the Due Process Clause were not met by a motion to compel, noted that a party cannot lump together counsel for a party and the persons from whom discovery is sought. In *Holcomb v. Allis-Chalmers Corp.*, 774 F.2d 398, 402 (10th Cir. 1985), the moving party argued that it was obligatory for counsel for the responding party to produce witnesses that had been designated as experts by the responding party. The court held that any argument that the motion was actually directed at the party and not the deponents "misses the point," and that the "requirements of Rule 37(a) were not met." *Id.* In the instant case, too, the requirements of the Rule were not met by the Plaintiffs. This is particularly significant because, as made clear in the attached affidavit, Ms. Brashears does not wish to be subjected to another deposition. ***See* Affidavit of Sarah**

Brashears, ¶ 14, Appendix, Exhibit A.

IV. CONVERSATIONS WITH FORMER EMPLOYEES ARE PROTECTED BY WORK-PRODUCT AND ATTORNEY-CLIENT PRIVILEGE

If this Court should find that the procedural defects in the Plaintiff's motion are not fatal, the substance of the arguments contained in the motion are still unavailing.

A. In the absence of Texas authority, the Court should look to federal law.

The Plaintiffs have failed to cite a single Texas case that suggests communications with a former employee are not protected by the attorney-client privilege and by the work-product privilege. Indeed, Fulbright is not aware of any Texas case addressing the matter one way or the other. Under such circumstances, Texas courts, in interpreting Texas work-product privilege, frequently turn to analogous federal case law:

> [T]he work product doctrine was firmly established in federal case law and codified in the federal rules when it was adopted in Texas. ***There is nothing to indicate that the Texas concept of "work product" was intended to be different from that of the federal courts. We have in the past looked to federal precedent in deciding work product questions.***

Nat'l Tank Co. v. Brotherton, 851 S.W.2d 193, 202 (Tex. 1993) (orig. proceeding) (citations omitted and emphasis added).[1] The same is true of attorney-client privilege:

> ***Because Texas courts have not decided whether the attorney-client privilege applies*** against a former corporate officer who had access to documents while a corporate officer, ***we look to other jurisdictions in deciding the issue.***

In re Marketing Investors Corp., 80 S.W.3d 44, 50 (Tex. App.—Dallas 1998) (orig. proceeding) (emphasis added).

B. Federal authority supports the upholding of privilege for communications with a former employee

[1] The Plaintiffs assert that Texas law of privilege governs the instant dispute. Notably, it has been suggested that the Texas rule of work-product privilege is ***broader*** than the analogous federal rule of privilege. *See In re Weeks Marine, Inc.*, 31 S.W.3d 389, 391 (Tex. App.—San Antonio 2000, orig. proceeding) (per curiam) ("Martinez may have been able to discover the documents in federal court, but he subjected himself to rule 192.5 by choosing to sue in state court.").

The great weight of federal authority supports Fulbright's assertion of privilege regarding communications with Ms. Brashears for fact-finding purposes. At least two federal circuit courts of appeal and a number of district courts have adopted this stance:

> Accordingly, ***we hold that the analysis applied by the Supreme Court in* Upjohn *to determine which employees fall within the scope of the privilege applies equally to former employees***. In this case, the Attorney General's Office employed [the former employee] during the time period in question and she possessed information relevant to [the attorney's] investigation. [The attorney] interviewed [the former employee] at the direction of her client, in order to provide legal advice to her client. Moreover, [the attorney] needed the information that [the former employee] could provide in order to develop her legal analysis for her client. ***Consequently, [the attorney's] notes and summary of her interview with [the former employee] are protected, and [the attorney] need not answer questions regarding her interview with [the former employee].***

In re Allen, 106 F.3d 582, 606 (4th Cir. 1997) (emphasis added).

> Communications between employees of a subsidiary corporation and counsel for the parent corporation, like ***communications between former employees and corporate counsel, would be privileged if the employee possesses information critical to the representation of the parent company and the communication concerns matters within the scope of the employment.***

Admiral Ins. v. United States Dist. Ct. for Dist. of Ariz., 881 F.2d 1486, 1493 n.6 (9th Cir. 1989) (emphasis added) (cited favorably by *United States v. Mobil Corp.*, 149 F.R.D. 533, 537 (N.D. Tex. 1993)).

The Fourth and Ninth Circuits have been joined by a number of district courts in opining that former employees may be treated as client representatives for privilege purposes. At least one of those courts has noted that former employee communications can give rise to both attorney-client and work-product privileges:

> Note that ***I draw no distinction between present and former employees in my application of the [attorney-client and work-product] privileges***. My formulation turns on whether the question will disclose a particular kind of information and not on the employment status of the witness who is asked the question.

Banks v. Office of the Senate Sergeant-at-Arms, 222 F.R.D. 1, 4 (D. D.C. 2004).

This overwhelming weight of authority is well-reasoned. When an organization is sued, as here, and a plaintiff complains of the conduct of an employee that is no longer employed by the organization, it is essential that the company be able to engage in fact-gathering to prepare its defense. In the instant litigation, Ms. Brashears was the attorney who spent the most time working on the Plaintiffs' matter. Communicating with her was necessary to obtain relevant information for Fulbright's counsel to advise its client. *In re Coordinated Pretrial Proceedings in Petroleum Products Antitrust Litig.*, 658 F.2d 1355, 1361 n.7 (9th Cir. 1981) ("Former employees . . . may possess the relevant information needed by corporate counsel to advise the client with respect to actual or potential difficulties."). The Plaintiffs waited until almost nine years after the '418 issued to file their lawsuit; predictably, memories have faded and key witnesses have passed away or left the employ of Fulbright. Under these circumstances, a valid privilege attaches to communications with Ms. Brashears.

To be sure, the Plaintiffs have found two trial-court federal decisions (one unpublished) that stand against the considerable body of case law according privilege to communications with former employees. Motion, pp. 6-7. The *Infosystems* court and the Plaintiffs both mistakenly suggest that "it is virtually impossible to distinguish the position of a former employee from any other third party who might have pertinent information about one or more corporate parties to a lawsuit." Motion, p. 7. The difference between a former employee and any other third party, however, is clear – and important. For purposes of privilege, a third party would not have had the inside access to the underlying facts relevant to Fulbright's defense that a former employee like Ms. Brashears would have had. This is particularly true in the unique context of a legal malpractice suit like the one the Plaintiffs have brought. Because conversations with Ms.

Brashears and the Plaintiffs during the patent prosecution are indisputably cloaked with attorney-client privilege and therefore confidential, there is by definition no "third party" that should rightfully possess information regarding the communications Ms. Brashears had with the Plaintiffs. The Plaintiffs' lawsuit complains of actions that Ms. Brashears took while she was employed by Fulbright. Ron Bliss, the Fulbright partner who supervised Ms. Brashears during the '418 prosecution, passed away before this litigation began, further heightening Fulbright's need to discuss the prosecution process with Ms. Brashears. Fulbright cannot obtain information about Ms. Brashears's actions from any third party; it can obtain it only from its former employee. This guiding principle has been voiced succinctly by a Massachusetts federal court: "Applying the attorney-client privilege to the communications at issue . . . would foster the flow of information to corporate counsel regarding issues about which [the company] was specifically seeking legal advice. The communications concerned actions taken by former employee Estis herself, about which she is the most knowledgeable person." *Command Transp., Inc. v. Y. S. Line (USA) Corp.*, 116 F.R.D. 94, 97 (D.C. Mass. 1987). Even the case cited by the Plaintiffs acknowledges that when a former employee is the only source of needed information, a privilege may apply:

> Moreover, there may be situations where . . . the present-day communication concerns a confidential matter ***that was uniquely within the knowledge of the former employee when he worked for the client corporation, such that counsel's communications with this former employee must be cloaked with the privilege*** in order for meaningful fact-gathering to occur.

Infosystems, Inc. v. Ceridian Corp., 197 F.R.D. 303, 306 (E.D. Mich. 2000) (emphasis added).

Indeed, if one pulls at the strings of the Plaintiffs theory, it unravels completely. For instance, suppose Ms. Brashears had left Fulbright ***after*** the Plaintiffs filed suit. Would the Plaintiffs contend that discussions between her and Fulbright's counsel the day before she left the firm were protected by privilege, but those the day after were not? The attorney-client privilege is not such a fleeting, fragile thing. Whether Ms. Brashears was interviewed about her recollection of relevant events before she left the firm or after, it was for the same purpose – for "facilitating the rendition of professional legal services" and "in anticipation of litigation" – which is what Texas Rule of Evidence 502(b)(1) and Texas Rule of Civil Procedure 192.5(a) protect. The law does not permit the nonsensical result for which the Plaintiffs argue.

C. Attorney-Client Privilege applies to communications between Ms. Brashears and Messrs. Paul, Beck, Gannaway, and Caldwell

In Texas, confidential communications between the client or a representative of the client and the client's lawyer or a representative of the lawyer made for the purpose of facilitating the rendition of legal services to the client are privileged. TEX. R. EVID. 503(b)(1). Affidavits attached from Messrs. Beck and Gannaway, as well as Ms. Brashears, reveal that all of the necessary elements for a valid claim of attorney-client privilege are present for the communications with Ms. Brashears. ***See*** **Affidavit of Sarah Brashears, Appendix, Exhibit A; Affidavit of David J. Beck, Appendix, Exhibit C; Affidavit of Geoff Gannaway, Appendix, Exhibit D.** As made clear by all of the above-cited federal cases, a former employee of a client can be a "representative of the client" for purposes of attorney-client privilege, as she provides a source of information based on her status as a prior employee – information that no other person can furnish. Thus, the communications between Ms. Brashears and Messrs. Beck, Gannaway, and Caldwell fall within the privilege set forth in TEX. R. EVID. 503(b)(1)(A).

The Plaintiffs advance the argument that Fulbright partner Tom Paul's communications with Ms. Brashears are not protected by attorney-client privilege "because [Paul] is not counsel for Fulbright." Motion, p. 2. This overly simplistic argument also is fatally flawed, as it ignores the text of the Texas rule, which provides that communications "between representatives of the client or between the client and a representative of the client," if made for the purpose of facilitating the rendition of professional legal services to the client, are privileged. TEX. R. EVID. 503(b)(1)(D). As set forth in Mr. Beck's affidavit, the discussions between Mr. Paul and Ms. Brashears, both representatives of Fulbright for purposes of their confidential communications, facilitated his rendition of legal services to Fulbright; accordingly, the discussions fall within the lawyer-client privilege.

D. Work-Product Privilege applies to communications between Ms. Brashears and Messrs. Paul, Beck, Gannaway, and Caldwell

As with their arguments regarding attorney-client privilege, the Plaintiffs continue to cling to their theory that Ms. Brashears cannot be a representative of Fulbright for the purposes of providing information. The attached affidavits show that the requirements for work-product privilege are met, and that communications with Ms. Brashears were made only for the purpose of obtaining information that she knew only because she was employed by Fulbright during the relevant time period. As such, she was acting as a "representative" of Fulbright for the purpose of Fulbright's counsel and representatives gathering the facts needed to prepare for litigation.

V. FEES SHOULD NOT BE AWARDED TO PLAINTIFFS; RATHER, DEFENDANT SHOULD BE AWARDED FEES FOR RESPONDING TO A PROCEDURALLY DEFECTIVE MOTION

The Plaintiffs have asked this Court to award fees and costs for them to return to California to depose Ms. Brashears. As an initial matter, flying counsel to California to ask Ms. Brashears a few questions regarding conversations with Fulbright attorneys and outside counsel would be an exercise in wastefulness. Should this Court decide that Ms. Brashears should be subjected to further deposition, the questioning should take place telephonically.

At any rate, Fulbright was "substantially justified" in claiming privilege for conversations with Ms. Brashears, given the substantial volume of case law supporting that privilege, and so

Rule 37(a)(4)(A) precludes the award of fees and costs to the Plaintiffs. Fulbright further objects to Plaintiffs' request for expenses because Plaintiffs have failed to comply with Local Rule CV-7(i)(1).

If, given the totality of the circumstances (including failure to observe the most basic requirements of Rule 37), the Court determines that it cannot be said that the Plaintiffs' "making of the motion was substantially justified," Rule 37(a)(4)(A) provides that the Court "shall" order that payment be made to Fulbright for the expense incurred in opposing the motion. If the Court makes such a determination, Fulbright respectfully requests the opportunity to be heard regarding the amount of expense incurred.

VI. CONCLUSION AND PRAYER

Fulbright respectfully requests that Plaintiff's Motion to Compel Deposition Testimony of Sarah Brashears be denied, that reasonable expenses be awarded to Fulbright, and that Fulbright be awarded such additional relief to which it may be entitled.

Respectfully submitted,

By: ______________________

David J. Beck
Texas Bar No. 00000070
Geoff A. Gannaway
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Houston, Texas 77010-2010
Telephone: (713) 951-3700
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ATTORNEYS FOR DEFENDANT FULBRIGHT & JAWORSKI, LLP

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing document was served as shown below on counsel of record on December 23, 2005.

Via Facsimile and Certified Mail, Return-Receipt Certified
Michael P. Lynn, P.C.
Jeffrey M. Tillotson, P.C.
John D. Volney
Jeremy Fielding
Lynn Tillotson & Pinker, LLP
750 N. St. Paul St., Suite 1400
Dallas, Texas 75201

Geoff A. Gannaway

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

IMMUNOCEPT, LLC, PATRICE ANNE LEE, AND JAMES REESE MATSON,	§	
	§	
Plaintiffs,	§	
	§	
v.	§	CAUSE NO. A050A334 SS
	§	
FULBRIGHT & JAWORSKI, LLP,	§	
	§	
Defendant.	§	

APPENDIX

Exhibit A – Affidavit of Sarah Brashears

Exhibit B – Subpoena issued by the Northern District of California

Exhibit C – Affidavit of David J. Beck

Exhibit D – Affidavit of Geoff Gannaway

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

IMMUNOCEPT, LLC, PATRICE ANNE LEE, AND JAMES REESE MATSON,	§	
	§	
Plaintiffs,	§	
	§	
v.	§	CAUSE NO. A050A334 SS
	§	
FULBRIGHT & JAWORSKI, LLP,	§	
	§	
Defendant.	§	

AFFIDAVIT OF SARAH BRASHEARS

THE STATE OF CALIFORNIA	§
	§
COUNTY OF SAN MATEO	§

Before me, the undersigned notary, on this day personally appeared Sarah Brashears, a person whose identity is known to me. After I administered an oath to her, upon her oath, she said:

1. My name is Sarah Brashears. I am over 18 years of age. I am of sound mind, and I am competent to make this affidavit. I have personal knowledge of and am personally acquainted with the facts stated herein.

2. The Plaintiffs in the above-captioned litigation sent me a subpoena issued by the United States District Court for the Northern District of California. Pursuant to the subpoena, I appeared for deposition in California on October 18, 2005.

3. I currently live and work in California.

4. I worked as an associate attorney in Fulbright & Jaworski, LLP's ("Fulbright's") Houston

EXHIBIT
A

office from 1993 to 1996.

5. During my deposition, I declined to testify as to the substance of conversations with Tom Paul, who is currently an attorney at Fulbright, as well as the substance of conversations with David Beck, Geoff Gannaway, and Rodney Caldwell, the three of whom I understand to be Fulbright's outside counsel in the above-captioned litigation.

6. The conversations with Messrs. Paul, Beck, Gannaway, and Caldwell all concerned facts related to the prosecution of the '418 patent that is at issue in the above-captioned litigation. I was aware of those facts only because of my employment at Fulbright from 1993 to 1996.

7. I spoke to Messrs. Paul, Beck, Gannaway, and Caldwell only regarding conduct or proposed conduct within the scope of my employment at Fulbright.

8. My conversations with Mr. Paul were over the telephone, and I was located in California when I provided information to him.

9. My conversations with Messrs. Beck, Gannaway, and Caldwell were in person, and we were all located in California when I provided information to them.

10. No other persons were present during my conversations with Messrs. Paul, Beck, Gannaway, and Caldwell.

11. I considered the information disclosed during my conversations with Messrs. Paul, Beck, Gannaway, and Caldwell to be confidential and have maintained it as such.

12. I have had no conversations in Texas regarding this litigation.

13. I was not given any notice by Plaintiffs or their counsel that they intended to apply for an order compelling further deposition testimony from me.

14. I would prefer to not be subjected to further depositions in this case."

FURTHER AFFIANT SAYETH NOT.

Sarah Brashears

SUBSCRIBED AND SWORN TO before me on the 19th day of December, 2005.

DMITRIY LAZAREV
COMM. #1530901
Notary Public-California
SANTA CLARA COUNTY
My Comm. Exp. Dec 2, 2008

Notary Public In and For

the State of California

Issued by the

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

Immunocept, LLC, Patrice Anne Lee and James Reese Matson
Plaintiffs
V.
Fulbright & Jaworski, LLP
Defendant

SUBPOENA IN A CIVIL CASE

Case Number:[1] A050A334 SS U.S. District Court
Western District TX
(Austin Div)

TO: Sarah Brashears (formerly Sarah Brashears Macatee)

YOU ARE COMMANDED to appear in the United States District court at the place, date, and time specified below testify in the above case.

PLACE OF TESTIMONY	COURTROOM
	DATE AND TIME

✓ YOU ARE COMMANDED to appear at the place, date, and time specified below to testify at the taking of a deposition in the above case.

PLACE OF DEPOSITION	DATE AND TIME
Morgan Lewis, 2 Palo Alto Square, 3000 El Camino Real, Suite 700, Palo Alto CA, 94306	9:00 a.m. October 19, 2005

✓ YOU ARE COMMANDED to produce and permit inspection and copying of the following documents or objects at the place, date, and time specified below (list documents or objects):

See Schedule A

PLACE	DATE AND TIME
Chao Hadidi Stark & Barker LLP, 770 Menlo Ave, #205, Menlo Park CA, 93062	by 5:00 pm, October 14, 2005

YOU ARE COMMANDED to permit inspection of the following premises at the date and time specified below.

PREMISES	DATE AND TIME

Any organization not a party to this suit that is subpoenaed for the taking of a deposition shall designate one or more officers, directors, or managing agents, or other persons who consent to testify on its behalf, and may set forth, for each person designated, the matters on which the person will testify. Federal Rules of Civil Procedure, 30(b)(6).

ISSUING OFFICER'S SIGNATURE AND TITLE (INDICATE IF ATTORNEY FOR PLAINTIFF OR DEFENDANT)	DATE
[signature] Plaintiff	Sept. 23, 2005

ISSUING OFFICER'S NAME, ADDRESS AND PHONE NUMBER
Chao Hadidi Stark & Barker LLP, 770 Menlo Ave, #205, Menlo Park CA 94025 (650) 325-0220

(See Rule 45, Federal Rules of Civil Procedure, Parts C & D on next page)

[1] If action is pending in district other than district of issuance, state district under case number.

EXHIBIT
B

(c) PROTECTION OF PERSONS SUBJECT TO SUBPOENAS.

(1) A party or an attorney responsible for the issuance and service of a subpoena shall take reasonable steps to avoid imposing undue burden or expense on a person subject to that subpoena. The court on behalf of which the subpoena was issued shall enforce this duty and impose upon the party or attorney in breach of this duty an appropriate sanction which may include, but is not limited to, lost earnings and reasonable attorney's fee.

(2) (A) A person commanded to produce and permit inspection and copying of designated books, papers, documents or tangible things, or inspection of premises need not appear in person at the place of production or inspection unless commanded to appear for deposition, hearing or trial.

(B) Subject to paragraph (d) (2) of this rule, a person commanded to produce and permit inspection and copying may, within 14 days after service of subpoena or before the time specified for compliance if such time is less than 14 days after service, serve upon the party or attorney designated in the subpoena written objection to inspection or copying of any or all of the designated materials or of the premises. If objection is made, the party serving the subpoena shall not be entitled to inspect and copy materials or inspect the premises except pursuant to an order of the court by which the subpoena was issued. If objection has been made, the party serving the subpoena may, upon notice to the person commanded to produce, move at any time for an order to compel the production. Such an order to comply production shall protect any person who is not a party or an officer of a party from significant expense resulting from the inspection and copying commanded.

(3) (A) On timely motion, the court by which a subpoena was issued shall quash or modify the subpoena if it

(i) fails to allow reasonable time for compliance,

(ii) requires a person who is not a party or an officer of a party to travel to a place more than 100 miles from the place where that person resides, is employed or regularly transacts business in person, except that, subject to the provisions of clause (c) (3) (B) (iii) of this rule, such a person may in order to attend trial be commanded to travel from any such place within the state in which the trial is held, or

(iii) requires disclosure of privileged or other protected matter and no exception or waiver applies, or

(iv) subjects a person to undue burden.

(B) If a subpoena

(i) requires disclosure of a trade secret or other confidential research, development, or commercial information, or

(ii) requires disclosure of an unretained expert's opinion or information not describing specific events or occurrences in dispute and resulting from the expert's study made not at the request of any party, or

(iii) requires a person who is not a party or an officer of a party to incur substantial expense to travel more than 100 miles to attend trial, the court may, to protect a person subject to or affected by the subpoena, quash or modify the subpoena, or, if the party in who behalf the subpoena is issued shows a substantial need for the testimony or material that cannot be otherwise met without undue hardship and assures that the person to whom the subpoena is addressed will be reasonably compensated, the court may order appearance or production only upon specified conditions.

(d) DUTIES IN RESPONDING TO SUBPOENA.

(1) A person responding to a subpoena to produce documents shall produce them as they are kept in the usual course of business or shall organize and label them to correspond with the categories in the demand.

(2) When information subject to a subpoena is withheld on a claim that it is privileged or subject to protection as trial preparation materials, the claim shall be made expressly and shall be supported by a description of the nature of the documents, communications, or things not produced that is sufficient to enable the demanding party to contest the claim.

SCHEDULE A

INSTRUCTIONS

1. Form of Response. The response to this subpoena shall state, with respect to each item or category, that inspection and related activities will be permitted as requested unless the request is objected to, in which event the reasons for objection shall be stated. If objection is made to part of an item or category, the part shall be specified.

2. This subpoena requires you to produce all responsive documents that are in your actual, or constructive possession, custody or control. In answering this subpoena, you are requested to furnish all information that is available to you (not merely such information as you know of your own personal knowledge), including information in the possession of your attorneys and accountants, other persons directly or indirectly employed by or connected with you or your attorneys or accountants, or anyone else acting on your behalf of otherwise subject to your control, regardless of where the document was created, originated or otherwise came into your possession, custody or control.

3. In answering. this subpoena, you are requested to make a diligent search of your records and of other papers and materials in your possession, custody, or control, including information in the possession of your attorneys and accountants, other persons directly or indirectly employed by or connected with you or your attorneys or accountants, or anyone else acting on your behalf or otherwise subject to your control.

4. Claim of Privilege. If you maintain that any document requested herein is protected from disclosure by the attorney-client privilege, the work product doctrine, or any other privilege or doctrine, then:

a. specify the nature of the privilege or doctrine you claim and the grounds for claiming it; and
b. identify the document, including its date, subject author(s), recipient(s), and all persons who have to your knowledge or belief seen it.

5. If you object to a request or any part thereof, produce all documents to which your objection does not apply.

6. If in answering a request you claim any ambiguity in the request or any part thereof. identify in your response the language you consider ambiguous, and state the interpretation you are using in responding.

7. In the event that multiple copies of a document exist, produce every copy on which appear any notations or markings of any sort not appearing on any other copy.

8. To the extent information responsive to this request is stored on software, an electronic or computer-based medium, or a data compilation, you shall provide the raw data along with all codes,and programs for translating it into useful form.

9. If you know of the existence, past or present, of any document described in this subpoena, but such document is not presently in your possession, custody or control or in the possession, custody or control of your agents, representatives or attorneys, you shall so state in response to this subpoena, identify such document in response to this subpoena, and identify the individual in whose possession, custody, or control the document was last. known to reside.. If such document no longer exists, state when, how, and why such document ceased to exist.

10. The documents produced in response to this subpoena shall be (i) organized and designated to correspond to the categories in this Request or, if not, (ii) produced as they are maintained in the normal course of business, and in either case:

a, all associated file labels, file headings, and file folders shall be produced together with the responsive documents from each file and shall be identified as to its owner or custodian;
b. all documents that cannot be legibly copied shall be produced in their original form; otherwise, you may produce photocopies; and
c. each page shall be given a discrete production number,

11. Wherever used herein, the singular shall be deemed in include the plural and plural shall be deemed to include the singular, the masculine shall be deemed to include the feminine and the feminine shall be deemed to include the masculine; the disjunctive ("or") shall be deemed to include the conjunctive ("and"), and the conjunctive ("and") shall be deemed to. include the disjunctive ("or"); and each of the functional words "each," "'every," "and," and. "all" shall be deemed to include each Of the other functional words

DEFINITIONS

As used herein, the following terms shall have the meanings indicated below and each time any such word is used in this first request for production of documents, you will be charged with knowledge of such definitions in responding. In each case, your response should respond to all the elements or questions included in such defined words.

1. The terms **"Plaintiff,"** or **"Plaintiffs,"** or any variant thereof, means **Plaintiffs Immunocept, LLC, Patrice Anne Lee and James Reese Matson,** and includes their past and present directors, officers, agents, predecessors, successors, assigns, legal representatives, non-legal representatives, personal representatives, attorneys, general partners, limited partners, employees, subsidiaries and parent companies, sister companies, affiliated entities, and also includes individuals and entities who act, have acted, purport to act, or have purported to act on behalf of Plaintiffs.

2. The term **"Fulbright"** means **Defendant Fulbright & Jaworski, LLP** and includes its past and present agents, legal representatives, non-legal representatives, personal

representatives, attorneys, employees, heirs, successors by merger and assigns, and also includes individuals and entities who act, have acted, purport to act, or have purported to act on behalf of Defendant Fulbright.

3. The term "**You**" or "**Your**" refers to the deponent, Sarah Brashears (formerly known as Sarah Brashears Macatee).

4. The term "**document**" has the broadest meaning ascribed to it under the Federal Rules of Civil Procedure and includes the original and each nonidentical copy of any written, printed, typed, filmed, recorded (electronically or otherwise), or other graphic matter of any kind or description, photographic matter, sound recordings or reproductions, however produced or reproduced, whether draft or final, as well as any summarization, compilation, or index of any documents. The term "document" includes, but is not limited to, letters, memoranda, reports, evaluations, x-rays, work records, studies, analysis, tabulations, graphs, logs, work sheets, work papers, medical records, correspondence, photographs, videotapes, films, slides, negatives, summaries, files, records, communications, agreements, contracts, invoices, checks, journals, ledgers, telegrams, telexes, hand-written notes, periodicals, pamphlets, computer or business machine printouts, accountants' work papers, accountants' statements and writings, notations or records of meetings, printers' galleys, books, papers, speeches, public relations issues, advertising, materials filed with government agencies, office manuals, employee manuals or office rules and regulations, reports of experts, and any other written matter.

5. The term "**person**" refers to any individual, corporation, general partnership, limited partnership, joint venture, association, joint-stock company, trust, incorporated organization, government or political subdivision thereof, and any other non-natural person of whatever nature.

6. The term "**Lawsuit**" means the case styled *Immunocept, LLC, Patrice Anne Lee and James Reese Matson*; Cause No. A 05 CA 334 SS, filed in the United States District Court, Western District of Texas, Austin Division.

7. The term "**all**" includes and encompasses "**any**." The term "**any**" includes and encompasses "**all**."

8. The word "**and**" and the word "**or**" shall be construed conjunctively or disjunctively as necessary to make the request inclusive rather than exclusive.

9. The term "**communication**," or any variant thereof, means any contact between two or more persons by which any information or knowledge is transmitted or conveyed, or is attempted to be transmitted or conveyed, between two or more persons and shall include, without limitation, written contact by means such as letters, memoranda, telegrams, telecopies, telexes, e-mails, or any other document, and any oral contact, such as face-to-face meetings or telephone conversations. The term also includes any notes, memorandum or other documents reflecting, summarizing or related to any such communications.

10. The phrases "relate to," "related to," and "relating to," or any variant thereof, include, but are not limited to, the following meanings: referring to, supporting, located in, considered in connection with, bearing, bearing on, evidencing, indicating, reporting on, recording, alluding to, responding to, concerning, opposing, favoring, connected with, commenting on, in respect of, about, regarding, discussing, showing, describing, reflecting, analyzing, constituting and being.

11. The term "'418 Patent" refers to United States Patent No. 5,571,418 issued on November 5, 1996 and entitled "Hemofiltration of Toxic Mediator-Related Disease."

12. The term "**Prosecution of the '418 patent**" refers to all communications between between Fulbright and the U.S. Patent and Trademark Office regarding the '418 patent and its parent application.

13. Any reference to an individual person, either singularly or as part of a defined group, includes that person's past and present agents, legal representatives, non-legal representatives, personal representatives, attorneys, employees, heirs, successors, and assigns, and also includes individuals and entities who act, have acted, purport to act, or have purported to act on behalf of such individual person.

14. Any reference to a non-natural person includes that person's past and present directors, officers, agents, predecessors, successors, assigns, legal representatives, non-legal representatives, personal representatives, attorneys, general partners, limited partners, employees, subsidiaries and parent companies, sister companies, affiliated entities, and also includes individuals and entities who act, have acted, purport to act, or have purported to act on behalf of such non-natural person.

15. The singular includes the plural and vice versa

16. The masculine gender includes the feminine and vice versa.

17. All other terms are to be interpreted in accordance with their normal usage in the English language.

DOCUMENTS

1. Please produce all documents related to the prosecution of the '418 Patent and its parent patent application.

2. Please produce all documents related to any training you underwent in preparation for the patent bar.

3. Please produce a copy of the license allowing you to practice before the United States Patent and Trademark Office ("USPTO").

4. Please produce documents sufficient to demonstrate when you were first licensed to practice before the USPTO.

5. Please produce a copy of the license that allowed you to practice law in the State of Texas.

6. Please produce documents sufficient to demonstrate when you were first licensed to practice law in any jurisdiction.

7. Please produce documents sufficient to demonstrate when you were first licensed to practice law in Texas.

8. Please produce all documents related to official or unofficial policies or practices at Fulbright concerning your supervision or the supervision of junior associates generally while you were employed by Fulbright.

9. Please produce all documents related to any formal and informal training you received while you were employed by Fulbright.

10. Please produce all documents related to the internal office procedures and policies concerning what the types of work you were allowed to perform at Fulbright.

11. Please produce all documents related to the internal office procedures and policies concerning what the types of work junior associates were allowed to perform at Fulbright while you were employed by Fulbright.

12. Please produce all documents related to Fulbright's assessment of your work including but not limited to periodic reviews.

13. Please produce all documents related to any complaints you had about your employment at Fulbright including but not limited to any issues related to training and supervision.

14. Please produce all documents related to the date and circumstances surrounding your departure from Fulbright.

15. Please produce a copy of the last five issued patents that you were responsible for prosecuting.

16. Please produce a copy of any documents you have related to the Plaintiffs.

17. Please produce a copy of any documents you have related to this lawsuit.

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

IMMUNOCEPT, LLC, PATRICE ANNE LEE, AND JAMES REESE MATSON,	§	
	§	
Plaintiffs,	§	
	§	
v.	§	CAUSE NO. A050A334 SS
	§	
FULBRIGHT & JAWORSKI, LLP,	§	
	§	
Defendant.	§	

AFFIDAVIT OF DAVID J. BECK

THE STATE OF TEXAS	§
	§
COUNTY OF HARRIS	§

Before me, the undersigned notary, on this day personally appeared David. J. Beck, a person whose identity is known to me. After I administered an oath to him, upon his oath, he said:

1. My name is David J. Beck. I am over 18 years of age. I am of sound mind, and I am competent to make this affidavit. I have personal knowledge of and am personally acquainted with the facts stated herein.

2. I am a licensed attorney in the State of Texas, and am a founding partner of the law firm of Beck, Redden & Secrest, LLP. Rodney Caldwell and Beck, Redden & Secrest LLP have been retained to represent Fulbright & Jaworski, LLP ("Fulbright") in the above-captioned litigation.

3. After being retained by Fulbright, Rodney Caldwell and I interviewed Sarah Brashears on October 5, 2004. Ms. Brashears is a former Fulbright associate that was involved in prosecuting the '418 patent that forms the basis of the Plaintiffs' allegations in this case.

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4. In view of her involvement in the prosecution of the '418 patent, Ms. Brashears possesses information critical to my representation of Fulbright in this litigation. The communications that Mr. Caldwell and I had with her concerned only actions that she took and knowledge that she gained within the scope of her employment at Fulbright, and about which she is the most knowledgeable person.

5. Mr. Caldwell and I interviewed Ms. Brashears because we needed information that we believed only she could provide in order to develop our legal analysis and to properly represent our client.

6. Tom Paul, who is an intellectual property lawyer and a partner at Fulbright, was requested to obtain information from Ms. Brashears to facilitate the rendition of legal services. He in turn, has informed me of the substance of conversations he had with Ms. Brashears after Fulbright was approached by the Plaintiffs regarding a possible claim against Fulbright. The information that Mr. Paul obtained from Ms. Brashears and conveyed to me facilitated my rendition of professional legal services to Fulbright.

7. Ms. Brashears was able to furnish information that was not known to anyone else that is currently at Fulbright. Mr. Ron Bliss, her supervisor and a partner at Fulbright, is now deceased.

8. The substance of the communications with Ms. Brashears has been kept confidential."

FURTHER AFFIANT SAYETH NOT.

David J. Beck

SUBSCRIBED AND SWORN TO before me on the 23rd day of December, 2005.

Notary Public In and For
the State of Texas

GAIL FULLER
MY COMMISSION EXPIRES
March 18, 2007

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

IMMUNOCEPT, LLC, PATRICE ANNE LEE, AND JAMES REESE MATSON,	§ §	
	§	
Plaintiffs,	§	
	§	
v.	§	CAUSE NO. A050A334 SS
	§	
FULBRIGHT & JAWORSKI, LLP,	§	
	§	
Defendant.	§	

AFFIDAVIT OF GEOFF GANNAWAY

THE STATE OF TEXAS	§
	§
COUNTY OF HARRIS	§

Before me, the undersigned notary, on this day personally appeared David. J. Beck, a person whose identity is known to me. After I administered an oath to him, upon his oath, he said:

1. My name is Geoff Gannaway. I am over 18 years of age. I am of sound mind, and I am competent to make this affidavit. I have personal knowledge of and am personally acquainted with the facts stated herein.

2. I am a licensed attorney in the State of Texas. I am an associate at the law firm of Beck, Redden, & Secrest, LLP.

3. Rodney Caldwell and Beck, Redden, & Secrest, LLP have been retained to represent Fulbright & Jaworski, LLP ("Fulbright") in the above-captioned litigation.

3. After being retained by Fulbright, Rodney Caldwell and I interviewed Sarah Brashears on the day before she was deposed by the Plaintiffs. Ms. Brashears is a former Fulbright associate

EXHIBIT
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D

who was involved in prosecuting the '418 patent that forms the basis of the Plaintiffs' allegations in this case.

4. In view of her involvement in the prosecution of the '418 patent, Ms. Brashears possesses information critical to my representation of Fulbright. The communications that Mr. Caldwell and I had with her concerned only actions that she took and knowledge that she gained within the scope of her employment at Fulbright, and about which she is the most knowledgeable person.

5. Mr. Caldwell and I interviewed Ms. Brashears because we needed information that we believed only she could provide in order to develop our legal analysis for our client.

6. Tom Paul, who is an intellectual property lawyer and a partner at Fulbright, was requested to obtain information from Ms. Brashears to facilitate the rendition of legal services. He in turn has informed me of the substance of conversations he had with Ms. Brashears after Fulbright was approached by the Plaintiffs regarding a possible claim against Fulbright. The information that Mr. Paul obtained from Ms. Brashears and conveyed to me facilitated my rendition of professional legal services to Fulbright.

7. Ms. Brashears was able to furnish information that was not known to anyone else that is currently at Fulbright.

8. The substance of the communications with Ms. Brashears has been kept confidential."

FURTHER AFFIANT SAYETH NOT.

Geoff Gannaway

SUBSCRIBED AND SWORN TO before me on the 23rd day of December, 2005.

Notary Public In and For
the State of Texas

GAIL FULLER
MY COMMISSION EXPIRES
March 18, 2007